

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.; AND
SAMSUNG ELECTRONICS AMERICA, INC.,
SONY CORPORATION; AND
SONY MOBILE COMMUNICATIONS INC.,
Petitioners,

v.

NEODRON LTD.,
Patent Owner.

Case No. IPR2020-01683
U.S. Patent No. 8,749,251

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

Patent Owner Neodron Ltd. and Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively “Samsung”), and Sony Corporation and Sony Mobile Communications Inc. (collectively “Sony”) have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, the parties jointly request termination of the *inter partes* review of U.S. Patent No. 8,749,251 (“Patent-in-Suit”), Case IPR2020-01683. The parties were authorized to file this Joint Motion by the Board (via email) on February 1, 2021.

As required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), true copies of the settlement agreements (Patent License Agreements and Escrow Agreement) that resolve the disputes in the above-captioned *inter partes* review relating to the Patent-in-Suit are filed herewith as confidential exhibits. There are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination sought. Due to confidentiality provisions of these Exhibits, Neodron is not permitted to share certain portions of the Escrow Agreement with any party other than the Court and its Staff. Neodron understands Samsung will similarly be filing a confidential exhibit (Exhibit A to the Escrow Agreement), that it is not permitted to share with any party other than the Court and its Staff. The Escrow Agreement filed by Neodron and Exhibit A to that agreement filed by Samsung together form the complete Escrow Agreement. The Parties have conferred on this matter, and the Parties are in agreement with this procedure.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Neodron and Samsung and Neodron and Sony are concurrently filing Joint Requests to Keep Separate, which ask the Board to treat the settlement agreements as business confidential information, and to keep them separate from the files of this proceeding and the files of the Patent-in-Suit.

I. Statement of Precise Relief Requested

The parties jointly request that the Board terminate the *inter partes* review of the Patent-in-Suit, Case IPR2020-01683, in its entirety.

II. Reasons Why Termination Is Appropriate

Termination of this proceeding with respect to all parties is proper. This *inter partes* review is still in an early stage. This Petition was filed on September 24, 2020.

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Because all parties request termination and the Board has not yet decided the merits of the proceeding, the Board should terminate the proceeding with respect to Samsung and Sony.

When there are no petitioners remaining in an *inter partes* review, the Board may terminate the proceeding entirely. 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. Samsung and Sony are the only petitioners in this *inter partes* review. All parties

support termination of this proceeding. With no petitioners remaining in the proceeding and no final written decision on the merits, termination of this proceeding entirely is appropriate.

The lawsuits between Neodron and Samsung and Neodron and Sony, involving the Patent-in-Suit are in the process of being dismissed concurrently with this *inter partes* review. The parties do not contemplate any litigation or proceeding involving the Patent-in-Suit in the foreseeable future.

III. No Future Participation by Petitioners

Samsung and Sony will not be participating further in this proceeding.

IV. Conclusion

The parties have settled all disputes relating to the Patent-in-Suit. This *inter partes* review is in an early stage, and the Board has not entered a final written decision on the merits in this proceeding. Accordingly, the parties respectfully request the Board to terminate this proceeding in its entirety.

Respectfully submitted,

Date: February 5, 2021

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